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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,080	09/30/2004	Rudolf Zurek	03-12-05	4213

30996 7590 11/14/2006

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EXAMINER

HAYES, BRET C

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/510,080	ZUREK, RUDOLF	
	Examiner	Art Unit	
	Bret Hayes	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>17 AUG 2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 17 AUG 05 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 19 – 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitations of ‘non-mechanically finished’, ‘coarse tolerances’, mechanically finished’ and ‘close tolerances’ are not clearly described in the specification. Page 2 of the written description, beginning at line 11, offers, “The basic concept of the invention consists in the separation of the frame construction into a coarsely tolerated, non-mechanically finished outer part that is welded onto the housing

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structure, and a closely tolerated, mechanically finished inner part". This cannot possibly apprise one of skill in the relevant art how these recitations are accomplished.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 19 – 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. By way of examples, claim 1: line 2, "a roof plate in which is disposed an opening" would more correctly be --a roof plate, in which an opening is disposed-- or --an opening disposed in a roof plate--; and, lines 5 & 6 "two parts that are disposed within one another", which is unlikely, and is presumed to be --two parts, wherein one is disposed within another--, but which does not particularly point out and distinctly claim such.

7. Claim 1 recites the limitation "the gun carriage" and "said gun carriage" in lines 5 & 9, respectively, which lack antecedent basis in the claim. Note that the claim recites "a carriage" in line 1, but no other. Is this "gun carriage" the selfsame carriage or a separate and distinct carriage? It would appear that it is separate and distinct and will be further treated as such for purposes of examination. Note also that it has been held that the recitation that an element is "adapted to" perform a function, see line 4, for example, is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchinson*, 69 USPQ 138). Further note that the recitation "via a pivot bearing" is not a

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positive recitation of that element because it is recited as part of the 'adapted to' phrase. Does the construction require a pivot bearing or not? For purposes of examination, it will be presumed that a pivot bearing is required.

8. Claim 26 recites the limitation "the smallest diameter" in line 3, which lacks antecedent basis in and obfuscates the claim. For purposes of examination, this limitation will be interpreted to mean --an inner diameter--, since such would normally be 'the smallest'. Further, lines 3 and 4 recite the limitations "an underside of which" and "an upper side of which", which are ambiguous because both 'a cylindrical ring' and 'said collar' have been previously recited. Because the metes and bounds of the claim cannot be accurately determined, the claim will not be further treated on the merits.

9. Claim 28 recites the limitation "said top pate" in lines 1 & 2. There is insufficient antecedent basis for this limitation in the claim. Further, lines 1 & 2 recite "at least one...have", which should be --at least one...has--.

10. Claims 29 & 30 are incomprehensible and cannot be further treated on the merits, for example, "wherein in a state of said inner part where it is inserted into said outer part". What is a *state* of the inner part? *What* is inserted where? As such, claim 31 cannot be further treated on the merits.

11. Claims 32 & 34 recite similar limitations as claims 29 & 30, "in a mounted state of said frame", where no mounted state has been disclosed other than that of a gun carriage being adapted to be mounted within the frame. It is not clear what is intended by these recitations. As such, claims 33, 35 & 36 cannot be further treated on the merits.

12. Any unspecified claim is rejected as being dependent upon a rejected base claim.

For purposes of examination, the claims that can be further treated on the merits will be so treated *as best understood* only.

The Manual of Patent Examining Procedure, section 2113,

Product-by-Process Claims

PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE IMPLIED BY THE STEPS

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

For purposes of examination, the claims that can be further treated on the merits will be so treated as Product-by-Process type claims.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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14. Claims 19 – 25 are rejected under 35 U.S.C. 102(b) as anticipated by US Patent No. 3,027,810 to Mueller.

15. Re – claim 19, Mueller discloses the claimed invention including an armored vehicle, as set forth at col. 2, line 11, for example, having a vehicle housing disposed on a carriage, which housing and carriage, whether explicitly stated as such or not, would certainly be inherent in any such vehicle, wherein an upper side of said vehicle housing has a roof plate in which is disposed an opening, bottom of FIG. 2, for example, said vehicle comprising: a frame 1 that surrounds said opening and in which is adapted to be mounted, via a pivot bearing 14, a gun carriage 3 of a weapon, wherein said frame comprises two parts that are concentrically disposed one within another and are secured to one another, namely an outer part 7 being fixed to said vehicle housing, and an inner part 11 being positively connected with said outer part, and wherein said pivot bearing for said gun carriage is disposed on said inner part, FIG. 2, for example.

16. Re – claims 20 – 24, Mueller further discloses wherein the outer part of the frame is provided with a collar 9 embodied as a closed ring. With respect to the ring being ‘composed of polygonally disposed collar plates...’, the prior art discloses the completed structure. The process used to make the product is immaterial to the patentability of that product. See above.

17. Re – claim 25, Mueller further discloses the ring having a circular inner periphery, as at 11, for example.

Conclusion

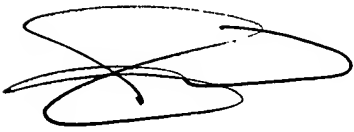
Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can

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normally be reached Monday through Thursday from 5:30 am to 4:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

A handwritten signature in black ink, appearing to read 'Bret Hayes', with a stylized, overlapping loop structure.

Bret Hayes

10-Nov-06